

REMARKS

Entry of this amendment is respectfully requested. Claims 42 and 44 as now pending have been placed into independent form, but are unchanged in scope. The subject matter added to the remaining pending claims has already been examined with respect to existing claims 42 and 44. The undersigned believes that this amendment should place the application into condition for allowance. If not, however, the case would be in better form for appeal. Certain claims have been canceled, and the amendments present narrowed issues for any appeal.

Applicants do not concede the propriety of the rejection contained in the last Office Action. Nonetheless, for purposes of simplifying the present application, the claims have now been amended, where necessary, to specify that the adaptation data comprises supplementary software for modifying original games content on the portable communication device. (It is contemplated that "original" includes game data present on the device before updating with the new adaptation data, and that this term is not necessarily limited to game data purchased with the device.)

As set forth in the previous response, it is submitted that Peng and Srinivasan do not render obvious any previously pending claim. In any case, the Peng and Srinivasan references do not render obvious the subject matter of previously pending claims 42 and 44 (now recast in independent form) and of the other claims of the application. The Office Action, in addressing claim 42, cited Peng's disclosure at column 1, lines 35-43 and column 15, lines 15-20. Applicants respectfully disagree. The Peng patent does include an oblique reference to games at column 1, line 42, but this does not constitute a disclosure of supplementary software for modifying original games content. Nor does

Peng's disclosure at column 15 support the rejection. Here, Peng purports to disclose certain features of an application "update process," but there is no disclosure of supplementary software for modifying original games content.

The Peng provisional application is similarly deficient. The Examiner has already noted the provisions of M.P.E.P. 2136.03, which require in this case the Peng provisional application to support the subject matter relied upon to make the rejection. Here, such support is not seen, which in retrospect is not surprising because the Peng patent itself is deficient. In light of this deficiency, which is not overcome by Srinivasan, withdrawal of the rejection is required.

There is an additional basis for withdrawal of the Section 103 rejection. The Examiner has failed to demonstrate that the Peng provisional application supports the claimed Peng invention under 35 U.S.C. Section 112. As noted In re Wertheim, 646 F.2d 527 (C.C.P.A. 1981) and subsequently in the M.P.E.P., it is incumbent upon the office in this case to demonstrate that the Peng provisional application supports the invention claimed in the Peng patent. The *Wertheim* court so held:

If, for example, the PTO wishes to utilize against an applicant, a part of that part of that patent disclosure found in that application filed earlier than a date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

646 F.2d at 537. The M.P.E.P. explicitly notes this requirement:

In order to carry back the 35 U.S.C. Section 102(e) critical date of the U.S. patent reference to the filing date of the parent application, the U.S.

patent reference much have a right of priority to the earlier date under 35 U.S.C. 120 or 365 (c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph.

M.P.E.P. 2161.03. Subsection III of this section clarifies that "the claims in a U.S. application are entitled to a benefit of ... the filing date of a provisional application if the corresponding provisional application supports the claims in a manner required by 35 U.S.C. 112, first paragraph." Accordingly, the M.P.E.P has recognized that the *Wertheim* rule applies to prior provisional applications in addition to Section 120 continuing applications.

In this case, as earlier noted, the Peng provisional application is a jumbled collection of documents that bears little resemblance to the issued Peng patent. The Examiner has not shown that any claim to the Peng patent is supported by the Peng provisional, and accordingly, has failed to demonstrate that Peng may be relied upon as prior art.

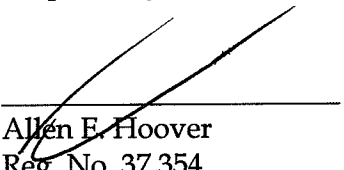
Of course, in any case, in light of the failure of the Peng patent to disclose the subject matter previously pending in claims 42 and 44, the Peng reference would be deficient even if it were available as prior art. Nothing in the Srinivasan reference overcomes this deficiency. Accordingly, the pending claims are patentable over the cited art.

For these reasons, withdrawal of the rejections and allowance of the application are respectfully solicited.

Respectfully submitted,

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